

Remarks

Initially filed were claims 1 to 20, which were canceled in a preliminary amendment in favor of claims 21 to 39. Based on the Supplemental Response "A" filed on 01 Oct. 2002, the status of the claims were: claims 21 to 78 were pending, of which claims 21, 40, 53, and 66 were independent. But due to a *sua sponte* constructive restriction in the Final Office Action dated 29 Oct. 2002, the Examiner withdrew claims 53 to 78 from consideration. In Amendment "C", the applicants canceled claims 53-78. After filing the Applicants' Appeal Brief on 25 April 2003 but before the Examiner filed his Examiner's Response, the Examiner reopened prosecution and issued an Office Action dated 09 July 2003, which rejected the remaining claims in view of newly cited prior art. In response thereto, the prior claims were then canceled in favor of the new claims added. The applicants also submitted a Rule 132 affidavit.

In the current Office Action dated 21 Jan. 2004, the Examiner issued a Final rejection of claims 79-81 and 83-87 over various prior art, and objected to claim 82, which would be allowable if rewritten in independent form. To this end, new claim 88 represents old claim 82 and intervening claims, which is now allowable.

Now pending are claims 79 to 88, of which claims 79, 86, 87, and 88 are independent. No new claim fee is believed due for new independent claim 88 as more than 4 independent claims have been paid for in the Response filed 25 Aug. 2002.

The Examiner rejected the claims under section 102(e) as being anticipated by Sidotti (5,865,851) and under section 102(e) as being anticipated by Tyerech (5,712,240). In response to these rejections, the Applicants are filing a Rule 131 affidavit to remove the references. As such the rejections are rendered moot in view of the prior art removal.

The affidavit and supporting documents show that the applicants had conceived of and diligently reduced to practice nonaqueous washing prior to the earliest effective filing dates of the section 102(e) references. The supporting documents also show that ideal working fluids are desirably inert and identified

several non exclusive candidates. One such document shows Fluoroinert and describes certain desirable chemical qualities, including that it has no deterative qualities and is non-reactive. In short, the documents evidence a conception and reduction to practice, thus removing the references from consideration.

Notwithstanding the sufficiency of the Rule 131 affidavit, the applicants also make the following statements related to the cited references.

The independent claims are amended solely to correct a typographical error that occurred during the last office action response. The independent claims are amended to delete the word "is" and insert the word "value". No subject matter is being relinquished and the applicants specifically note that the amendment is not made to overcome any prior art, any prior art rejection, nor is a narrowing amendment.

Flynn (4,636,328)

The Examiner asserts that Flynn anticipates the invention. In particular, the Examiner asserts in para. 17 that "Flynn teaches compositions containing surfactants (see col. 6, lines 13-30), solvents including alcohols and fluorinated freons (see col. 7, lines 5-25), enzymes, bleaches, water, and perfume (see examples of prespotter formulas, cols. 7-8)." In para. 18, the Examiner asserts that concerning "the applicant's requirement for specific KB values, as the applicant's requirements for the working fluid have been met by the prior art compounds, such limitations as KB value would be inherent to the prior art compounds."

For a single reference to anticipate, it must disclose each limitation as claimed. Multiple reference combination cannot yield an anticipation because the proper vehicle for rejecting claims based on multiple references in combination is via a section 103 obviousness rejection. Without a doubt, Flynn does not teach a working fluid. In para. 18, the Examiner admits that the "prior art compounds" teach the required KB values. The Examiner admits in para. 17 that the ingredients listed putatively qualify as the other ingredients of the claimed composition. So these ingredients of course cannot qualify as the working fluid.

With respect to para. 18, it is unclear which “prior art compound” teaches the KB values. If the Examiner asserts that the prior art compound is taught in Flynn (which inferentially the Examiner believes it is because of the section 102 rejection), then that is not true, as explained below. If the Examiner asserts that the prior art compounds come from non-Flynn art, then there are two errors with this. The first error is that the Examiner failed to identify which prior art is meant. The Examiner bears the burden of identifying the relevant piece of prior art that forms the basis of the rejection. To the extent that the relevant prior art is Sidotti and/or Tyerech, those references are removed from consideration. The applicants are unsure whether the Examiner means Flynn, Sidotti, Tyerech, or the prior art cited in the last series of Office Actions.

The second error is that a section 102 anticipation rejection requires that Flynn teach the claimed working fluid having the required KB value. To the extent that the Examiner is relying on Flynn plus another reference, then it is improper to use section 102 anticipation as the vehicle for rejection.

To the extent that the Examiner believes that a working fluid as claimed is taught in the Flynn reference, then this is incorrect. Starting at column 6, the very nature of the Flynn prespotter is to actively remove stains. Flynn then recounts what his prespotter formula contains. Column 6 discloses surfactants in Section A; in column 7 Flynn teaches solvents, enzymes, bleaches, and “other ingredients.” But nothing in column 6 or 7 teaches a working fluid.

The Examiner has pointed to the Examples in cols. 7-8 as exemplary ingredients. Taking Example I into consideration, this is a “stick” composition and for that reason alone, it cannot be working fluid. Second, the ingredients themselves fail to teach a working fluid. Igepal and Tergitol are surfactants (see Tyerech reference, col. 14, lines 25-35). Carbowax is an emulsifier, whereas Esperase is an enzyme. It is not surprising that the non reactive working fluid is not taught because the purpose of Flynn’s invention is to actively react with the fibers to treat stains.

Examples II and III are no better. In Example II, the tetrachloroethylene is a solvent. It inherently has a high KB value greater than 30 because the solvents

described in col. 7, lines 6-7 indicate that the chosen solvents are those chosen for "their ability to solubilize oily and greasy soils." Plainly these are not nonreactive working fluids as claimed. In Example II, the Neodol is a surfactant and hence is not a working fluid. Finally, the hydrocarbon of C₁₀-C₁₆ length is not a working fluid as claimed because this hydrocarbon is very oleophilic. Again, this is not surprising given that the very purpose of the prespotter is to treat stains and be reactive with the stain.

Example III fares no better. Alfonic 1412 is a surfactant. The other ingredients cannot be a working fluid. For example, enzymes are not working fluids. Water cannot be a working fluid because the working fluid claimed is non-aqueous. Perfumes and dyes equally flunk the requirements.

In short, Flynn fails to teach a working fluid as claimed. Because the Examiner indicated that Flynn served as the basis for the section 102 anticipation rejection, as a matter of law, Flynn ought to have taught a working fluid. It does not.

The Flynn reference teaches a stain removal prespotting composition that is used prior to washing the clothes normally. That is, the very purpose of the composition is to actively react with the stain so that stain removal becomes easier later during normal laundering. As such, each ingredient in the prespotter is to provide some type of aggressive cleaning so that the subsequent laundering is better.

As amended in claims 86 and 87, subparagraph (d) is amended to delete the reference to the antistatic and antistain agents. The remaining at least one second washing additive is not taught in Flynn. Flynn fails to teach ozone, UV light absorber, or a deodorizer. That is not surprising given that the prespotter is used in pre-laundering a fabric, which will ultimately be then thrown into a washing machine for aqueous cleaning.

Sidotti (5,865,851)

The Examiner cites Sidotti as a section 102(e) reference. Sidotti by its plain language fails to anticipate because it fails to teach the inert working fluid.

Claim 79 (as do the other independent ones) calls for a working fluid having specific characteristics in combination with a fragrance. The Examiner facially stated in the Office Action (paras. 8-10) that certain fluoro containing compounds are present in Sidotti. But therein lies the error. These fluoro containing compounds are not inert working fluids. They are, as the Examiner expressly admitted they are, fluorosurfactants. So to the extent that paras. 8-10 may suggest that some fluoro-containing compounds are present, they are by definition surfactants. Because they are surfactants they are not inert working fluids. It is important to note that simply matching up chemical names in the prior art with the chemical names in the claim does not establish patentability. Rather the very type of fluoro compound contemplated by Sidotti is a surfactant. It is also clear that the bulk fluid in Sidotti is the water. Accordingly, Sidotti at best teaches in its entirety that other ingredients may be used, but nowhere is an inert working fluid as claimed is taught. It is axiomatic that where one claimed limitation is missing from the prior art (and Sidotti is not prior art), anticipation cannot be established.

Tyerech (5,712,240)

Tyerech fares no better for the same reasons described herein. The Examiner has found various ingredients in the reference (see Para. 13, 15 of Office Action). In para. 14, he explicitly equates the working fluid to the fluoroethers, described in col. 6, lines 1-20). Upon closer inspection however, this is erroneous. Tyerech teaches a composition used for cleaning carpets and imparting oil/water repellency. It describes the prior art as containing fluoro compounds as being surfactants or reacting with fabrics to confer repellency (see, col. 2). The Examiner specifically pointed out in para. 14 that the Fluorad is the kind of fluoro-containing compound that corresponds to the working fluid. Fluorad is a surfactant (see, <http://surfactants.net/s-comp.htm>, visited on 18 March 2004, showing that Fluorad, a product of 3M Corp., is a fluorinated surfactant). Each mention of fluoro-containing compounds in Tyerech is that it is a surfactant. There is no discussion at all that it is an inert working fluid.

It is again important to note that simply because a fluoro-containing compound is shown in a reference does not mean that it is the type of compound that can qualify as an inert working fluid as claimed. The inert working fluid is described by various adjectives. To this end, any disclosure of a compound in Tyerech does not make that compound a working fluid. In short, matching a fluoro-compound with claim 81, for example, is not the appropriate test because it fails to encompass the elements of the independent claims.

Conclusion

The applicants request withdrawal of the rejections and believe that the claims as presented represent allowable subject matter. But if the Examiner desires, the applicant is ready for an interview to expedite prosecution. As always, the Examiner is free to call the undersigned at 312-443-1836.


The Examiner's attention is also directed to the new correspondence address.

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